

### **REMARKS**

In an Office Action dated June 7, 2006, Claims 6-11 and 48-53 were allowed while claims 54, 55, 60-64, 69-73, 78, and 80 were finally rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 5,569,901 to Bridgelall et al. ("Bridgelall"). Also, claims 56-59, 65-68, and 74-77 were rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the invention. A Request for Continued Examination ("RCE") is concurrently filed to remove the "final" status of the application. See *MPEP* §706.07(h).

According to the *MPEP* §2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Regarding claims 55, 60, 62-64, 69, 71, 73, 78, and 80, the Examiner states: "The distinction between the pending claims and the Bridgelall patent is whether use of a single digitizer or a plurality of digitizers wherein a digitizer is associated with a given parameter. It is the Examiner's view that use of a single digitizer or a plurality of digitizers are an obvious design variation element, in that each parameter is adjusted to achieve optimal reading conditions." *June 7, 2006 Office Action*, pp. 3-4.

As best understood, the Examiner has admitted that the Examiner has failed to indicate a teaching in Bridgelall relating to "a plurality of digitizers...wherein each of the

plurality of digitizers is configured to operate over a respective parameter range..." in the context of the remaining claim elements where such elements are recited.

Official notice without documentary evidence to support an Examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR §1.13. Official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). *MPEP §2144.03*

If the Examiner wishes to maintain the rejections of claims rejected based on Official Notice, the Examiner is respectfully requested to provide documentary evidence in support of the various assertions of common knowledge. *MPEP §2144.03(A)*. In providing such evidence, the Examiner is respectfully requested to make reference to the specific combinations of elements of applicants' claims (and not merely the elements of the dependent claims without reference to the elements of the base claim). The Examiner is also respectfully requested to set forth explicitly the reasons for the various rejections based on Office Notice. See *MPEP §2144.03(B)*. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. *MPEP §2144.03(B)*. It would not be appropriate for the Examiner to take Official Notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known. *MPEP §2144.03(A)*.

Regarding the Examiner's resorting to a design choice rejection, i.e., reliance on "official notice" the Examiner's reliance on official notice is not sufficient to sustain the rejection of claims 55, 55, 60, 62-64, 69, 71, 73, 78, and 80.

Regarding independent claim 63, the remarks herein related to independent claim 54 and 62 are incorporated by reference. Further regarding claim 63, it is respectfully asserted that the Examiner has not considered all of the elements recited in claim 63. For example, whereas claim 63 recites "an image sensor including plurality of photosensitive elements" and a "lens assembly focusing an image onto said image sensor" the Examiner has not shown or even alleged that Bridgelall teaches or suggests "an image sensor including plurality of photosensitive elements" or a "lens assembly focusing an image onto said image sensor."

Regarding claim 72, which recites a "two dimensional image sensor comprising a plurality of pixels formed in a plurality of rows and columns of pixels" the Examiner alleges that "the light detector 620 is capable of handling two dimensional barcode." It is respectfully asserted that having the capability of reading a two dimensional bar code does not satisfy the positively set forth claim limitation of a "two dimensional image sensor comprising a plurality of pixels formed in a plurality of rows and columns of pixels" and, therefore, that the Examiner has not established that references of prior art either alone or in combination have all of the recited claim elements of claim 72.

Further regard the Office Action of June 7, 2006, the Examiner's statement that "Bridgelall discloses a single processor" is not understood. The applicants do not recite hardware limitations in any claim, and in fact, claim 80 recites that each of a plurality of digitizers can be a plurality of software modules.

Further regarding claims 56-64, 65-68, and 74-77, as far as the rejections under 35 U.S.C. §112 are understood, the Examiner alleges that the term "indicia" renders claims 56-64, 65-68, and 74-77 unclear. Applicants note that in sections of the

supporting description, e.g., at paragraph [0107] of U. S. Patent Publication No. 2005/0056699, "bar code contrast," "bar code color contrast," "motion induced blur," and "bar growth" are described without reference to the term "indicia." Accordingly, in order to traverse the rejections under 35 U.S.C. §112, applicants remove reference to the term "indicia" in claims 56-64, 65-68, and 74-77.

Regarding the claims discussed herein, the applicants' selective treatment and emphasis of independent claims of the application should not be taken as an indication that the applicants believe that the Examiner's dependent claim rejections are otherwise sufficient. In fact, it is noted in the June 6, 2006 Office Action, that the dependent claims are rejected without substantial, and in certain instances, without any reference to the limitations of the dependent claims in combination with the base claim elements. In rejecting claims for want of novelty or for obviousness, the Examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 C.F.R. §1.104 (d)(2).

While the applicants have concentrated on the independent claims for purposes of demonstrating insufficiency of the Examiner's rejections, the lack of discussion respecting the dependent claims should not be taken as an indication that the applicants believe that the rejections of the dependent claims are otherwise correct. Applicants expressly reserve the right to present arguments supporting patentability of the dependent claims in a future response.

Further, while the applicants herein may have highlighted a particular claim element for purposes of demonstrating an insufficiency of an examination on the part of an Examiner, the applicants highlighting of a particular claim element for such limited purpose should not be taken to indicate that the applicants have taken the position that

a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present. Further, while applicants may have highlighted a particular claim element for the limited purpose of demonstrating an insufficiency in the examination, applicants expressly reserve the right to argue for patentability of any of the pending claims in this or a related application on grounds other than those specifically discussed here.


Accordingly, in view of the above amendments and remarks, applicants believe all of the claims of the present application to be in condition for allowance and respectfully request reconsideration and passage to allowance of the application.

If the Examiner believes that contact with applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

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Respectfully submitted,

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